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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,135	05/25/2001	Ros-Marie Furtenback	27943-411C1	4603
27045	7590	06/21/2005	EXAMINER	
ERICSSON INC. 6300 LEGACY DRIVE M/S EVR C11 PLANO, TX 75024			QURESHI, AFSAR M	
			ART UNIT	PAPER NUMBER
			2667	

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/866,135

Applicant(s)

FURTENBACK ET AL.

Examiner

Afsar M. Qureshi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/25/2001, withdrawal of allowance 6/2/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 62-72 is/are allowed.
- 6) ☒ Claim(s) 29-46, 48 and 51-61 is/are rejected.
- 7) ☒ Claim(s) 47, 49 and 50 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/9/2002.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The indicated allowability, dated June 2, 2005, of claims 1-72 is withdrawn in view of:

- i) The newly discovered reference(s),
 - ii) Double patenting with respect to other applications,
 - iii) Preliminary amendment, dated 5/25/2001 (made of record recently) wherein Applicant cancelled claims 1-28. Claims 29-72 remain in the application
- Rejections based on the newly cited reference(s) follow.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 29, 32, 37, 38, 42, 43, 51-61 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-7, 17 and 38-40 of copending

Application No. 09/764,960.

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Claims 29, 37, 38, 42 and 51 (09/866,135) are broader and contain all the limitations of claim 1 (09/764,960).

Claim 32 (09/866,135) same as claim 5 (09/764,960)

Claims 52-57 (09/866,135) same as claims 2-7 (09/764,960), respectively,

Claims 58 - 61 (09/866,135) same as claims 37 - 40 (09/764,960)

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

The claimed first node and the second node configured to provide call control functions and connection control functions (claims 29 and 38) with switching intelligence for selectively routing a communication through switching band fabric (narrowband or broadband) are functionally same as narrowband component and the broadband component with switching intelligence, similarly, the claimed STM switch and ATM (claim 32) are also claimed in copending application (claim 5) as above.

Additionally, the method of terminating a TDM inbound side of a first communication at a circuit switch and terminating a TDM outbound side of the first communication at the circuit switch and terminating a TDM inbound side of a second communication at the circuit switch (claims 58 - 61) are also claimed in claims 37-40 of the copending application 09/764,960.

It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*,

136 USPQ 184 (CCPA 1963). Also note Ex Parte Rainu, 168 USPQ 375 (Bd.

App.1969). Omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art. This line of reasoning would be the basis of an obvious type double patenting rejection.

This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

3. Claims 29, 30, 31, 32, 34, 35, 36, 40, 42, 43, 44 and 51 are provisionally rejected under the judicially created doctrine of double patenting over claims 1, 2, 14, 8, 10, 3, 7, 6, 14, 15,16 and 9 respectively, of copending Application No. 09/765,119.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: All the limitations, such as, first node, configured to provide call control functions; second node connected to first node by a link and configured to provide connection control functions; first node including STM switch (first switch) and second node including ATM switch (second switch), can be found in claims 1- 3, 7, 8, 14-16 of the above referred copending application.

It is well settled that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*,

136 USPQ 184 (CCPA 1963). Also note Ex Parte Rainu, 168 USPQ 375 (Bd. App. 1969). Omission of a reference element whose function is not needed would be obvious to one of ordinary skill in the art. This line of reasoning would be the basis of an obvious type double patenting rejection.

This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

4. Claims 29 - 38 are provisionally rejected under the judicially created doctrine of double patenting over copending Application No. 09/764,622 of claims:

Claims 29 and 38 (09/866,135) over claims 1 and 11 (09/764,622)

Claims 30, 31 (09/866,135) over claims 2, 3 (09/764,622), respectively

Claim 32 (09/866,135) over claims 4 and 14 (09/764,622)

Claim 34 (09/866,135) over claim 6 (09/764,622)

Claim 35 (09/866,135) over claim 18 (09/764,622)

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

Claims 29-32, 34, 35 and 38 (09/866,135) are rejected based on the double patenting for the same reasons as described in paragraphs 2 and 3 above.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other

copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

5. Claims 29, 30, 31, 34 and 38 are rejected under the judicially created doctrine of double patenting over claim 1 of U. S. Patent No. 6,775,266 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: first node, configured to provide call control functions; second node connected to first node by a link and configured to provide connection control functions are described having similar functions as that of narrowband switching node and broadband switching node of the above referred Patent. The Examiner contends that, especially, claims 29 and 38 are broader version of claim 1 of the Patent.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application that matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 29-34, 37- 43, 51-57 are rejected under 35 U.S.C. 102(b) as being anticipated by Holler et al. (WO 98/28884).

Holler discloses a narrowband terminal (first node) 203 and broadband terminals (second node) 209, 211 (figures 2 & 4). Narrowband terminal is connected to broadband terminal by first link (**claims 29, 38, 42, 43**). Narrowband and broadband terminal including switching intelligence and a narrowband switching fabric and function as a single logical unit since the logical node, represented by 213 and 217 (figure 2), may receive and forward communication in narrowband format or in broadband format to another logical node, e.g. 215 and 219, (**claims 33, 37, 39, 40, 45, 46, 51**) broadband terminals do not provide call control functions and rely on narrowband terminal for the same (page 6 -page 7) (**claims 30, 31**). Holler further discloses narrowband terminal includes narrowband switches that act as STM switches and broadband terminals include broadband switches that act as ATM switched that is used, functionally, as a hybrid switch in an ATM/STM network (figure 3 page 6, second paragraph, see pages 5 through 9) (**claims 32, 34, 41**). Holler discloses that a broadband component (also meet

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the limitation of a packet-based switch) may terminate incoming and outgoing sides of communication (figure 2, page 9, first paragraph, method 5), value added services (third communication) may be invoked while connecting a call (page 8, 4th paragraph), broadband component relies on the switching intelligence of the narrowband component (pp 6-7) (**claims 52-54**). Holler further discloses narrowband switches that act as STM switches, and ATM switches that are broadband switches (Page 6, second and third paragraphs), a switch emulator function 217 (*at least one circuit emulator*), wherein a broadband emulates a circuit connection (pp 6-7) (**claims 55-57**).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 35, 36, 44, 58 - 61 rejected under 35 U.S.C. 103(a) as being unpatentable over Holler in view of Allen Jr. et al. ("Allen"), US 2001/0017861.

Claims 35, 36 and 44. Holler does not specifically disclose that first and second nodes are connected to a TDM network and first node is further connected to and intelligent network, as in claim 44 herein. However, Allen discloses that narrowband (first node) and broadband (second node) devices are connected to TDM network and

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ATM network (see page 3 [0026]). Allen also discloses that the invention applies to broadband advanced intelligent network (AIN) (see page 9, paragraph [0101].

Claims 58-61. Holler discloses terminating narrowband inbound side of a communication at a circuit switch; switching the first communication by the circuit switch and terminating a narrowband outbound side if the communication at the switch.

Additionally, Holler discloses terminating a narrowband inbound side of a communication at the circuit switch, switching the communication by the circuit switch, switching the communication by a packet switch, and terminating and ATM bound side of the communication at the packet switch (see pp 6-9, figs. 2, 3, 4, 5, 6)

Holler further discloses that the logical node represented by narrowband component 213, and broadband component 217 may receive and transmit communications in either narrowband format or broadband format to another logical node, represented by 215 and 219 (figure 2), as in claims 59 and 61. Similarly, as to claim 60, Holler discloses that value added services (third communication) may be invoked while connecting a call (see page 8, paragraph 4).

Holler fails to disclose that the narrowband side of a communication is a TDM side of a communication.

However, Allen discloses that TDM may be a form of narrowband communication (see [0026], page 3).

Therefore it would have been obvious to one skilled in the art, at the time of invention, to be able to modify Holler by including TDM as a narrowband form of

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communication in order to provide narrowband based telephony services to users utilizing services on narrowband form of communication.

9. Claims 45, 46 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holler in view of Christie et al. ("Christie"), US 6,480,493.

Holler discloses limitations, such as, receiving signaling information and data information, sending signaling information to second node (see paragraph 7 above).

Holler does not specifically disclose producing, by the second node, routing instructions and sending back to the first node and first node then sends the data information, to second node, based on routing instructions.

However, Christie, in the same field of endeavor, discloses a call processing procedure in an intelligent network producing routing information and forwarding the communication to another node over a second link (see col. 15, lines 54 through col. 16, lines 1-21).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of invention, to modify Holler by including signaling processing by processing the call and generating new signaling incorporating the processing and transferring to network elements as appropriate in order to provide telecommunications services to users of the ATM systems with narrowband and broadband connections, signaling links and signaling processors especially if signaling processors reside externally to the ATM switches.

Allowable Subject Matter

10. Claims 62-72 are allowed over prior art of record.

The following is a statement of reasons for the indication of allowable subject matter:

The closest prior art, Holler et al. and Christie et al., fail to disclose "an internetworking entity, operatively connectable to first node and plurality of nodes that include broadband switching fabric, receives data in a first format from first node, map the data in a second format interoperable by plurality of second nodes controlled by the switching intelligence of first node", as in claim 62.

11. Claims 47, 49 and 50 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record fails to disclose "first node includes *broadband switch* and second node includes *narrowband switch fabric and a switching intelligence*".

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Davies et al. (US 2002/0017861 ; Constantinof et al. (US 6,381,246); Doshi et al. (US 5,568,475 and US 5,483,527).

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Afsar M. Qureshi* whose telephone number is (571) 272 3178. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Chi Pham* can be reached on (571) 272 3179. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


AFSAR QURESHI
PRIMARY EXAMINER

June 13, 2005